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In re Application of:

WEBLER, WILLIAM EARL

Serial No.: 10/027,877

Filed: Dec. 19, 2001

Docket: 5618P2977

Title: METHOD AND APPARATUS FOR
DETERMINING INJECTION DEPTH
AND TISSUE TYPE

DECISION ON PETITION TO
ENTER AMENDMENT AFTER
FINAL

This is a decision on the petition filed on Nov. 27, 2006 to enter the amendment after final under 37 CFR 1.116.

The petition is **DISMISSED**.

In the petition, petitioner requested a review of the Advisory Action issued by the examiner on Oct. 26, 2006. In the Advisory Action, the examiner refused to enter the amendment after final filed on July 5, 2006 because the newly amended claim 1 would require additional consideration. Petitioner stated that the newly amended claim 1 was same as the cancelled dependent claim 2. The limitation in the canceled dependent claim 2 was combined with independent claim 1 to establish antecedent basis of "needle" in claims 3 and 4 and correct a mistake by replacing "elongated member" with "needle" in lines 3 and 4 of claim 1. There was no new issue involved because the examiner already considered the limitation of dependent claim 2 in his previous Office actions. Petitioner requested that the amendment after final be entered for appeal purposes.

The record shows that:

- 1) In response to the non-final Office action of Jan. 24, 2006, on Apr. 27, 2006, the applicant submitted an amendment canceling claim 2 and placing all limitations with the independent claim 1. In particular, the applicant replaced the term "elongated member" with "needle" which was the term used in dependent claims 2. The applicant inadvertently failed to make the change of dependency of the dependent claims 3 and 4.

- 2) Subsequently, in the final rejection of May 23, 2006, the examiner brought to the applicant's attention by rejecting claims 3 and 4 under 35 USC 112, 2nd paragraph.
- 3) On Jul. 5, 2006, the applicant filed an amendment after final under 37 CFR 1.116 to correct the mistakes in claim 1 and the dependent claims 3 and 4.
- 4) The examiner issued the Advisory Action on Oct. 26, 2006 stating that the newly amended claim 1 containing the addition of "needle" which constitutes new limitation that would require further consideration.
- 5) On Nov. 27, 2006, the applicant filed the present petition to request entry of the amendment after final for appeal purposes.

Applicable Rule

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal. (a) An amendment after final action must comply with §1.114 or this section. (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title): (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action; (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

Analysis of File Records

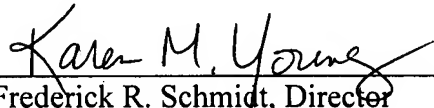
In order to determine whether or not that the amendment after final raises new issue, a comparison of the newly amended claim 1 with other dependent claims filed on Jul. 5, 2006 and the previous cancelled dependent claim 2 with other dependent claims must be made. As correctly pointed out by petitioner, the scopes of the newly amended claims 1, 3 and 4 as filed on Jul. 5, 2006 were not changed from the now cancelled dependent claims 2 and amended claims 3 and 4 filed on April 27, 2006. However, the scopes of unamended dependent claims 5 and 10 of Jul. 5, 2006 were changed from dependent claims 5 and 10 of Apr. 27, 2006. In particular, dependent claim 5 now requires the claimed "elongated member is a rod" in combination with the newly amended "distal portion of the needle" in claim 1. Dependent claim 10 also requires the claimed "a portion of elongated member comprises an electrically conductive material... and coupled to a second end of the heating element" in combination with the "distal portion of the needle" of claim 1. Whereas the subject matter of the dependent claim 10 of April 27, 2006 did not include the combination with "distal portion of the needle" of claim 1 of Jul. 5, 2006. This limitation "distal portion of the needle" in claim 1 of Jul. 5, 2006 raised the new issue in dependent claims 5 and 10 that would require further consideration by the examiner. For example, in addition to the art rejection of the claims, the examiner still needs to consider each and every amended claim under 35 USC 112.

Based on the arguments presented in the petition, the amendment after final filed on Jul. 5, 2006 would have placed claims 1, 3 and 4 in better condition for appeal purposes if the applicant also

had canceled the unamended dependent claims 5 and 10. The new issue stated in the advisory action lies with the unamended dependent claims 5 and 10. The current amendment after final filed on Jul. 5, 2006 does not satisfy the conditions set forth in 37 CFR 1.116 (b) (1) and (2). Therefore, the amendment after final filed on Jul. 5, 2006 cannot be entered as correctly indicated by the examiner in his advisory action of Oct. 26, 2006.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3736 for further processing. Any renewed petition must be filed within TWO (2) MONTHS of the date of the Decision and the time for filing an appeal brief will not be stayed either by the filing of the instant petition or renewed petition (see 37 CFR 1.181f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

PETITION DISMISSED

for 

Frederick R. Schmidt, Director
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